

REMARKS/ARGUMENTS

In the Office action mailed June 18, 2009, claims 20-39 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite, claims 20-23, 26, 33-34, and 38-39 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,754,938 to Herz et al. (“Herz”) in view of Pfitzmann and Kohntopp, Anonymity, Unobservability, and Pseudonymity — A Proposal for Terminology, LNCS 2009 (“Pfitzmann”), claims 24-25, 27-31, and 35-37 were rejected under 35 U.S.C. § 103(a) as unpatentable over Herz in view Pfitzmann and further in view of Engberg and Harning, Privacy Authentication — persistent non-identification in Ubiquitous environment (“Engberg”^{*}), and claim 32 was rejected under 35 U.S.C. § 103(a) as unpatentable over Herz in view Pfitzmann and further in view of U.S. Patent Pub. No. 2006/0155993 to Busboon (“Busboon”) and further in view of Engberg. The Office action included a second grounds for rejection and rejected claims 20-31 and 33-39 under 35 U.S.C. § 103(a) as unpatentable over Int’l Pub. No. WO 01/90968 to Engberg. (“Engberg-1”) in view of Pfitzmann and rejected claim 32 as 35 U.S.C. § 103(a) as unpatentable over Engberg-1 in view of Pfitzmann and further in view of Busboon and further in view of Engberg. The Office action also included claim and specification objections. The Examiner is thanked for detailed attention to the application.

Claims 20-39 were pending in the application. Claims 20-24, 26-27, 29-30, 32-34, 36-39 are amended. Claim 28 is cancelled. Support for the amendments to independent claims 20 and 33 is given below. The dependent claims were amended to properly refer to the amended wording of the independent claims.

Claim Objections

The Office action objected to claim 32 for potential antecedent basis problems. The term “payment accept” has been amended to “said payment acceptance” to match the prior “transmitting

^{*} The same publication is referred to as “Engberg-2” beginning at page 36 of the Office action. The term “Engberg” is used in this response.

a payment acceptance.” Accordingly, it is respectfully requested that the objections to claim 32 be withdrawn.

Specification Objections

The Office action objected to the specification for not providing a proper antecedent basis the “a first identity device,” “a second identity device,” and “a third identity device,” and “a further identity device.” While it is believed that the objection is improper, for example as indicated in a prior response to Office action, to expedite prosecution, the claims have been amended to use “chip card” and “communication device.” This amendment is made solely to expedite prosecution, and applicant reserves the right to present claims with the prior terminology during later prosecution of this or another application. The terms “chip card” and “communication device” are used and described throughout the specification, for example, (for convenience citing to the published United States patent application) in each of Figures 1-13 and in the text beginning at paragraph 68 of the published application (U.S. Patent Pub. No. 2007/0106892). It is believed that the specification provides proper antecedent basis for terms in the amended claims. Accordingly, it is respectfully requested that the objections to the specification be withdrawn.

Rejections under 35 U.S.C. § 112

The Office action rejected claims 20-39 as indefinite.

In claims 20 and 33, the term “one-time-only privacy reference point” was deemed to be of uncertain definition. Amended claim 20 recites “providing a privacy reference point in said data communication network, said privacy reference point configured for use in one transaction” and amended claim 33 recites “a privacy reference point in said data communication network, said privacy reference point configured for use in one transaction.” Privacy reference points (PRPs) are described in particular in paragraphs 84-89 of the published application with protocols for generating and sharing privacy reference points described in paragraphs 177-184 of the published application. Exemplary transactions using a PRP are described throughout the application, for example, using digital cash is described in paragraphs 77-78 of the published application and using anonymous credit is described in paragraphs 80-82 of the published application. Additionally, the one transaction use of a privacy reference point is described in

paragraph 85 of the published application: “Whenever a transaction is initiated a PRP is provided by the Chip Card as the transaction specific identifier or one-time-only card number.”

In claim 33, “means for providing authentication” and “means for establishing a second communication path” were deemed to lack structure disclosed in the specification. Amended claim 33 recites “means for verifying an authentication of said chip card relative to said privacy reference point from said chip card” and “a second communication path from said privacy reference point to a communication device representing an entity through said data communication network.” The claimed “means for verifying an authentication” are described, for example, in paragraphs 113-115 of the published application, including storage of “one-way encoded version of the biometrics template.” The second communication path is shown, for example, in Figs. 1 and 2 as one of the paths to the shown PRPs.

In claim 37, “means for verifying employs data selected from a group of . . .” was deemed to lack structure disclosed in the specification. It is believed that the amendment to claim 33 and discussion above points out corresponding structure described the specification.

In claim 20, “establishing communication” on lines 12 and 15-16 was deemed unclear. Amended claim 20 recites “establishing a first communication path” and “establishing a second communication path” and is believed to be definite.

In claim 33, “establishing communication” on line 15 was deemed an unclear reference. Amended claim 33, recites “wherein at least one of the means for verifying the authentication and the second communication path is operable without disclosing the identity of said chip card to said communication device.” The “second communication path” is defined in the prior clause of amended claim 33.

As each item leading to a section 112 rejection is addressed above, it is respectfully requested that the rejections be withdrawn.

First ground for rejection under 35 U.S.C. § 103

The Office action rejected claims 20-39 as being unpatentable over Herz in view of Pfitzmann (additionally in view of Engberg for claims 24-25, 27-31, and 35-37 and further in view of Busboon of claim 32).

Amended claim 20 recites in part “providing a privacy reference point in said data communication network, said privacy reference point configured for use in one transaction.” Regarding this aspect of pre-amendment claim 20, the Office action asserts “a proxy server is equivalent to a private reference point.” Office action, p. 9. However, Herz describes its proxy server as a server computer.

A proxy server, e.g. S2, is a server computer with CPU, main memory, secondary disk storage and network communication function and with a database function which retrieves the target profile interest summary and access control instructions associated with a particular pseudonym P, which represents a particular user U, and performs bi-directional routing of commands, target objects and billing information between the user at a given client (e.g. C3) and other network entities such as network vendors V1-Vk and information servers I1-Im.

Herz, col. 34, lines 27-36. Whereas the claimed privacy reference point is described as a “virtual address[] based on a domain offset link and a relative reference.” Published application, para. 84. Accordingly, Herz does not teach or suggest “providing a privacy reference point in said data communication network, said privacy reference point configured for use in one transaction” as recited in amended claim 20 and is not a proper basis for finding claim 20 obvious.

Amended claim 20 additionally recites “establishing a first communication path from said chip card to said privacy reference point.” Herz does not appear to teach or suggest use of a chip card. Accordingly, claim 20 is further nonobvious over the prior art.

The Office action equates various features of Herz’s system to the claim limitation and then states “Herz is silent about one-time-use pseudonym (i.e. one-time-use reference (‘privacy reference point’).” Office action, p. 11. However, Herz is not silent about one-time use of its pseudonyms. Herz requires a single pseudonym to be used repeatedly between a user and a provider.

From the service provider's perspective, our system provides security, in that it can guarantee that users of a service are legitimately entitled to the services used and that no user is using multiple pseudonyms to communicate with the same provider. This uniqueness of pseudonyms is important for the purposes of this application, since the transaction information gathered for a given individual must represent a complete and consistent picture of a single user's activities with respect to a given service provider or coalition of service providers; otherwise, a user's target profile interest summary and user profile would not be able to represent the user's interests to other parties as completely and accurately as possible.

Herz, col. 32, line 66 to col. 33, line 11.

Assuming *arguendo* that Herz and Pfitzmann teach what is asserted in the Office action, the combination is improper because the proposed modification would render the system of Herz unsatisfactory for its intended purpose. Limiting the pseudonyms in the system of Herz to use in one transaction would render it inoperable for its intended purpose because in Herz a “pseudonym is an artifact that allows a service provider to communicate with users and build and accumulate records of their preferences over time.” Herz, col. 31, lines 48-51. Use of a pseudonym for one transaction would appear to prevent a service provider in Herz’s system from building and accumulating records over time.

Accordingly, the Office action does not make a prima facie case of obviousness based on the combination of Herz and Pfitzmann. Furthermore, there is no apparent reason a person having ordinary skill in the art at the time of the invention would have combined or modified the teachings of Herz, Pfitzmann, and the other art of record to arrive at the method of claim 20. Thus is respectfully requested that this rejection be withdrawn with respect to claim 20 and claims 21-27 and 29-32 that depend from claim 20.

Regarding claim 33, the Office action states, “Claim 33 is essentially the same as claim 20 except that they set forth the claimed invention as a system rather than a method and rejected under the same reasons as applied above.” Office action, p. 14.

Amended claim 33 recites in part “a privacy reference point in said data communication network, said privacy reference point configured for use in one transaction.” As discussed above regarding claim 20, the proxy server described by Herz is not equivalent to the claimed “privacy reference point.”

Amended claim 33 additionally recites “a first communication path from said chip card to said privacy reference point.” As discussed above regarding claim 20, Herz does not appear to teach or suggest use of chip card.

Furthermore, the improper combination of Herz and Pfitzmann discussed above regarding claim 20 also applies to claim 33.

Accordingly, the Office action does not make a prima facie case of obviousness based on the combination of Herz and Pfitzmann. Furthermore, there is no apparent reason a person having

ordinary skill in the art at the time of the invention would have combined or modified the teachings of Herz, Pfitzmann, and the other art of record to arrive at the system of claim 33. Thus is respectfully requested that this rejection be withdrawn with respect to claim 33 and claims 34-39 that depend from claim 33.

Second ground for rejection under 35 U.S.C. § 103

The Office action rejected claims 20-39 as being unpatentable over Engberg-1 in view of Pfitzmann (additionally in view of Busboon and in view of Engberg for claim 32).

Amended claim 20 recites in part “providing an authentication of said chip card relative to said privacy reference point.” Regarding this aspect of pre-amendment claim 20, the Office action points to the abstract and p. 6, line 21 to p. 7, line 11 of Engberg-1 and quotes “providing second legal entity with authentication or profile information related to said communication path and/or first legal entity.” However, the claimed authentication is relative to “said privacy reference point” and not to a second legal entity. Accordingly, Engberg-1 does not provide disclosure to make a prima facie case of obviousness.

Amended claim 20 additionally recites “establishing a first communication path from said chip card to said privacy reference point.” Engberg-1 does not appear to teach use of a chip card. Accordingly, claim 20 is further nonobvious over the prior art.

Accordingly, the Office action does not make a prima facie case of obviousness based on the combination of Engberg-1 and Pfitzmann. Furthermore, there is no apparent reason a person having ordinary skill in the art at the time of the invention would have combined or modified the teachings of Engberg-1, Pfitzmann, and the other art of record to arrive at the method of claim 20. Thus is respectfully requested that this rejection be withdrawn with respect to claim 20 and claims 21-32 that depend from claim 20.

Regarding claim 33, the Office action states “Claim 33 is essentially the same as claim 20 except that they set forth the claimed invention as a system rather than a method and rejected under the same reasons as applied above.” Office action, p. 34.

Amended claim 33 recites in part “means for verifying an authentication of said chip card relative to said privacy reference point from said chip card.” As discussed above regarding claim 20, the authentication described in Engberg-1 differs from that presently claimed.

Amended claim 33 additionally recites "a first communication path from said chip card to said privacy reference point." As discussed above regarding claim 20, Engberg-1 does not appear to teach use of a chip card.

Accordingly, the Office action does not make a prima facie case of obviousness based on the combination of Engberg-1 and Pfitzmann. Furthermore, there is no apparent reason a person having ordinary skill in the art at the time of the invention would have combined or modified the teachings of Engberg-1, Pfitzmann, and the other art of record to arrive at the system of claim 33. Thus is respectfully requested that this rejection be withdrawn with respect to claim 33 and claims 34-39 that depend from claim 33.

Summary

In summary, it is respectfully submitted that claim 20-27 and 29-39 are patentable over the art of record and show be allowed. Passage of the application to issue is therefore earnestly solicited.

Respectfully submitted,

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